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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional):

2002-021/PU03 0061US1

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Date: **August 11, 2006**

Signature:

Typed or printed name: **KATHLEEN KOPPEN**

Application Number:

10/696,864

Filed:

October 30, 2003

First Named Inventor:

Eaton

Art Unit:

2617

Examiner:

**MARIVELISSE
SANTIAGO CORDERO**

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

(Form PTO/SB/96)

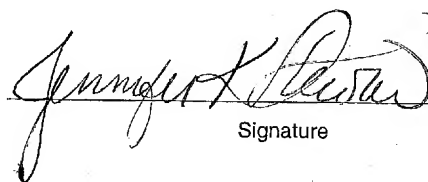
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attorney or agent of record

Registration Number: 53,639☐

attorney or agent acting under 37 CFR 1.34.

Registration Number if acting under 37 CFR 1.34 _____



Signature

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August 11, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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*Total of _____ form(s) is/are submitted.

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. ¹ Applicant's unique citation designation number (optional). ² Applicant is to place a check mark here if English language Translation is attached. This collection of information is required by 37 CFR 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

In re Application of Eaton

Serial No.: 10/696,864
Filed: October 30, 2003

For: A Mobile Device with a Combination Attachment and Acoustic Port

Docket No: 2002-021

PATENT PENDING

Examiner: Marivelisse Santiago-Cordero

Group Art Unit: 2617

Confirmation No.: 8058

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11 August 2006

Date _____

Kathleen Koppen
Kathleen Koppen

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ARGUMENTS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

In response to the Final Office Action (FOA) mailed 13 June 2006, Applicant files a Notice of Appeal along with a Pre-Appeal Brief Request for Review. The following arguments provide the basis for the Review Request.

Claims 1 – 31 are pending, where claims 1, 13, 16, and 25 are independent claims. In the FOA, the Examiner maintains that DuMont (US5331760) anticipates independent claims 1, 16, and 25 under §102(b). In addition, the Examiner maintains that Raven (US5164987) anticipates independent claims 1, 13, 16, and 25 under §102(b), and that Kumar (WO 01/06344) anticipates independent claims 1, 13, 16, and 25 under §102(b). All of these rejections rely on the Examiner's interpretation of the claimed "port." As discussed in further detail below, the §102 rejections are improper because the Examiner's position regarding the interpretation of the word "port" is legally insufficient.

Independent claims 1, 16, and 25 are directed to a mobile device having a combined attachment and acoustic port. The claimed port includes an attachment member designed to secure an external member to the mobile device. By combining these individual elements into a single combined element, the claimed mobile device efficiently utilizes available space.

Independent claim 13 represents a corresponding method claim.

The ordinary meaning of the word "port" is an opening or recess in a housing. As shown in Applicant's response communication dated 5 May 2006, Merriam-Webster supports this definition. Applicant notes that if extrinsic reference sources, such as dictionaries, evidence more than one definition for the term, the intrinsic record must be consulted to identify which of the different possible definitions is most consistent with applicant's use of the terms. *Brookhill-Wilk 1*, 334 F. 3d at 1300, 67 USPQ2d at 1137; see also *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1250, 48 USPQ2d 1117, 1122 (Fed. Cir. 1998). The only definition of "port" that satisfies the ordinary meaning requirement and that logically applies to the claimed invention is the definition that the claimed port is an opening or recess.

The specification provides further support that the claimed "port" is an opening or recess in the housing (see p. 5, ll. 16 – 17 of the specification). In response to this argument, the Examiner asserts that the claims do not explicitly recite an opening because the Examiner interprets the term "port" to include any structure that projects audible sound, even if the structure does not include a recess or opening in or on the housing (see FOA p. 2, last two lines and p. 3, ll. 1 – 2). However, neither the specification nor the ordinary meaning of the term "port" supports the Examiner's position. As such, the Examiner's position is legally erroneous. Because Applicant's specification defines the term port to mean an opening or recess (p. 5, ll. 16 – 17), this definition must be used to control the interpretation of the word "port" as used in the claims. See *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999), *In re Vogel*, 422 F.2d 438, 441, 164 USPQ 619, 622

(CCPA 1970), and *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875, 69 USPQ2d 1865, 1868 (Fed. Cir. 2004).

In light of the above remarks, the broadest reasonable interpretation of the claim term “port” requires that the claimed “port” be construed as an opening or recess. If the Examiner insists on applying other definitions to the term “port,” Applicant respectfully requests that the Examiner explicitly state the applied definition. Further, Applicant respectfully requests that the Examiner provide legal evidence that the Examiner’s definition may be reasonably applied to Applicant’s claim language. This evidence must be consistent with existing patent law and with the precedent associated with existing case law, including the above-cited case law. Absent such a showing, the rejection must be withdrawn.

Contrary to the Examiner’s assertions, DuMont does not teach or suggest a mobile device having any type of port, much less a combined attachment and acoustic port. Instead, DuMont describes a fishing lure having a speaker in a watertight housing, where the housing has no recesses or openings of any kind, and where the speaker projects sound through the solid housing wall. Because DuMont’s fishing lure does not include any openings or recesses, DuMont’s fishing lure does not include any type of port. As such, DuMont does not anticipate independent claims 1, 16, and 25.

Raven also does not teach or suggest the claimed combined attachment and acoustic port. Instead, Raven describes a pair of glasses having a fabric earflap hanging from each temple piece of the glasses, where each earflap holds a speaker. As with Dumont, the Examiner interprets Raven’s earflap to correspond to the claimed port simply because the speaker projects sound through the earflap. However, as discussed above, the claimed port must be interpreted as an opening or recess. Because Raven’s earflap does not include any type of opening or recess, Raven does not describe any type of port, much less the claimed

combined attachment and acoustic port. As such, Raven does not anticipate independent claims 1, 13, 16, and 25.

Lastly, Kumar also does not teach or suggest the claimed combined attachment and acoustic port. Instead, Kumar describes a handset having a speaker port and an ear loop. While the ear loop is disposed near the speaker port, nothing in Kumar supports the Examiner's position that the ear loop is part of the speaker port. Instead, Kumar simply teaches that the ear loop is secured to the handset and positioned around the speaker. Simply because the ear loop is positioned near the speaker port does not mean that the ear loop is part of the speaker port. In response to these arguments, the Examiner asserts that the claims do not require that the attachment member be part of the combination port (see FOA p. 4, ll. 13 – 15). However, contrary to the Examiner's assertions, the independent claims explicitly require that the combined attachment and acoustic port includes the attachment member¹. Because Kumar's ear loop is not part of the speaker port, Kumar does not teach or suggest the claimed combination port. As such, Kumar does not anticipate independent claims 1, 13, 16, and 25.

Applicant further submits that nothing in the cited art teaches or suggests that the attachment member comprises a support bar disposed in the combined port, as required by independent claim 16 and dependent claims 2 – 5, 14, 26, and 27. In response, the Examiner asserts that DuMont's attachment member 19 and 73 – 75 is part of the DuMont's port. However, as discussed above, DuMont's fishing lure does not include a port. Further, the attachment member in DuMont is simply secured to the housing near the location where the speaker projects sound. This is not the same as a support bar that is disposed in a port (claims 2 – 5, 26, and 27). Further, DuMont's attachment member does not span across a recessed

¹ Claim 1: "a combined attachment and acoustic port...including an attachment member..."

Claim 13: "placing an attachment member in the acoustic port"

Claim 16: "the combination attachment and acoustic port including a surrounding wall structure and at least one attaching bar extending across the port"

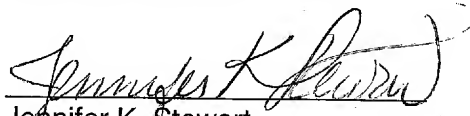
Claim 25: "a combination port...comprising...attaching means for attaching an external member"

2 – 5, 26, and 27). Further, DuMont's attachment member does not span across a recessed acoustic port, as required by claim 14. Similarly, nothing in Raven or Kumar teaches or suggests that the attachment member is disposed in or spans the combined port. As such, at least claims 2 – 5, 14, 26, and 27 add patentably distinct limitations to the invention of the independent claims.

In light of the above remarks, Applicants submit that claims 1 – 31 are new and non-obvious over the cited art. Therefore, Applicants respectfully request that the Review Panel reverse the Examiner's rejections.

Respectfully submitted,

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Dated: 11 August 2006

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